

## **GNSO Council Recommendations Report to the ICANN Board – Regarding Adoption of the Phase 1 Final recommendations from the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process**

8 February 2021

### **Status of This Document**

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This is the GNSO Council Recommendations Report to the ICANN Board following the GNSO Council's approval of the Phase 1 final recommendations of the Review of All Rights Protection Mechanism in All gTLDs Policy Development Process.

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## 1. Executive Summary

On 21 January 2021, the GNSO Council [voted](#) to approve by a GNSO Supermajority all the recommendations contained in the [Phase 1 Final Report](#) from the Working Group that had been chartered to conduct a Policy Development Process (PDP) on the Review of All Rights Protection Mechanisms (RPMs) in All gTLDs. This Recommendations Report is being sent to the ICANN Board for its review of the thirty-five (35) Phase 1 final recommendations, which the GNSO Council recommends be adopted by the ICANN Board. Please see Annex A of this Recommendations Report for a summary of all the approved recommendations.

The GNSO Council [chartered](#) the PDP for the review of RPMs to be conducted in two phases. Phase 1 focused on reviewing the RPMs and associated structures and procedures applicable to gTLDs launched under the 2012 New gTLD Program, specifically:

- The Uniform Rapid Suspension System (URS);
- The Trademark Clearinghouse (TMCH);
- The Sunrise and Trademark Claims services offered through the TMCH; and
- The Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP).

Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP), which has been an ICANN Consensus Policy since 1999.

The Working Group published its [Phase 1 Initial Report](#) for public comment on 18 March 2020. Following a careful review of all public comments received from fifty-five (55) contributors as well as extensive discussions over a number of additional recommendations developed as a result of the public comment review, the Working Group finalized its recommendations and submitted its [Phase 1 Final Report](#) to the GNSO Council on 24 November 2020.

The Working Group has classified its recommendations for each of the Phase 1 RPMs into three categories:

1. Recommendations for new policies or procedures – a total number of fifteen (15) recommendations
2. Recommendations to modify existing operational practice – a total number of ten (10) recommendations; and
3. Recommendations to maintain the status quo (i.e. as the Phase 1 RPMs were implemented for the 2012 New gTLD Program) – a total number of nine (9) recommendations.

As the Working Group experienced difficulties in obtaining quantitative data concerning the effectiveness of the Phase 1 RPMs, it also put forward an Overarching Data Collection Final Recommendation aimed at addressing this data-related gap.

Among the thirty-five (35) Phase 1 final recommendations, the Working Group reached full consensus on thirty-four (34) recommendations and consensus on one (1) recommendation, which was the TMCH Final Recommendation #1. A Minority Statement was jointly filed by seven

(7) members of the Working Group with regard to the TMCH Final Recommendation #1, which can be found in Annex D of the Final Report. It is important to note that the Minority Statement did not oppose the primary thrust of the recommendation but noted concerns over the scope of “word marks” that can be accepted into the TMCH.

The policy recommendations, if approved by the Board, will impose obligations on contracted parties, as well as service providers with respect to the TMCH, URS, and TM-PDDRP. Under the ICANN Bylaws Section 11.3(i)(x), the GNSO Council’s Supermajority support for these recommendations obligates the Board to adopt the recommendations unless, by a vote of more than two-thirds, the Board determines that the policy is not in the best interests of the ICANN community or ICANN.

## 2. GNSO Vote

*If a successful GNSO Vote was not reached, a clear statement of all positions held by Council members. Each statement should clearly indicate (i) the reasons underlying each position and (ii) the Constituency(ies) or Stakeholder Group(s) that held that position.*

The GNSO Council unanimously approved the Working Group's Phase 1 Final Report, which exceeded the Supermajority threshold. The vote results can be found [here](#).

### 3. Analysis of Affected Parties

*An analysis of how the issue(s) would affect each Constituency or Stakeholder Group, including any financial impact on the Constituency or Stakeholder Group.*

The Working Group's fifteen (15) recommendations for new policies or procedures, ten (10) recommendations to modify existing operational practice, and one (1) recommendation for overarching data collection are expected to have operational, financial, and/or other impact on the following parties:

- The GNSO's Stakeholder Groups and Constituencies, including registry operators and registrars who have to implement new requirements and improvements to existing processes;
- RPM-related service providers, including the TMCH Validation Provider, TMCH Database Provider, URS Providers, and TM-PDDRP Provider; and
- ICANN org, which will have to, among other things, update its documentation and related materials concerning the TMCH and the Applicant Guidebook for future expansions of new gTLDs, and collaborate with the RPM-related service providers and Contracted Parties to implement the new policies and procedures.

The Working Group's membership included participants from all the GNSO's Stakeholder Groups and Constituencies except for the Internet Service Providers and Connectivity Providers Constituency (ISPCP), ICANN's Advisory Committees, RPM service provider representatives, and individuals with interest and expertise in trademark law and the RPMs. ICANN org also provided extensive comments to the Working Group's Initial Report, which helped shape the final scope of the PDP recommendations.

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## 4. Period of Time Needed to Implement Recommendations

*An analysis of the period of time that would likely be necessary to implement the policy.*

In addition to the thirty-five (35) Phase 1 final recommendations, the Phase 1 Final Report included a substantial amount of implementation guidance, which are intended to provide supplemental and/or clarifying information to assist with implementation of the recommendations. The Working Group recognized that substantial time and effort will be needed to translate the recommendations into policy language and operational requirements, as well as the complexity of implementing these recommendations with the involvement of various stakeholders.

Implementation planning can commence immediately upon the Board's adoption of these recommendations. The GNSO Council has requested that ICANN org convene an RPM Implementation Review Team (IRT), as is the regular practice and in accordance with the IRT Principles & Guidelines approved in 2016.

Furthermore, under its Charter requirements, the Working Group coordinated its work with other relevant efforts underway and took into consideration the outcome of these efforts, including the TMCH Independent Review, the Competition, Consumer Trust and Consumer Choice Review (CCT), the Expedited PDP (EPDP) on the Temporary Specification for gTLD Registration Data, and the New gTLD Subsequent Procedures (SubPro) PDP.

Some of the Working Group's Phase 1 recommendations will affect future expansion round(s) of new gTLDs. In particular, the Working Group proposed specific changes to the Applicant Guidebook and/or the Base Registry Agreement. As such, should the GNSO Council and the Board also approve the PDP recommendations from the newly completed SubPro PDP, it will be important for the RPM IRT and the expected SubPro IRT to coordinate their efforts to ensure consistency. The GNSO Council is expected to consider a suggestion by one of the SubPro PDP Co-Chairs to subsume implementation of RPM recommendations aimed at new gTLDs into a work track of the future SubPro IRT for efficiency, and to use a separate IRT to implement the rest of RPM recommendations.

In view of the expected workload, resource allocation, and the need for coordination with other parallel efforts, implementation of the Phase 1 final recommendations may take a minimum of two (2) years following Board adoption. However, this timeline is likely to be impacted by the timing of the approval of the SubPro PDP recommendations (including whether the Board also initiates an Operational Design Phase to plan for the SubPro implementation).

## 5. External Advice (If Any)

*The advice of any outside advisors relied upon, which should be accompanied by a detailed statement of the advisor's (i) qualifications and relevant experience; and (ii) potential conflicts of interest.*

As this PDP is the first time that the RPMs have been subject to a policy review by the ICANN community, there were no comprehensive studies or data collected that measured their effectiveness. The Working Group agreed early on in its work that, in order to fulfill its Charter requirements and effectively review each of the Phase 1 RPMs, it would need to analyze any available data (including data reported by Registry Operators and the various service providers to ICANN org) as well as gather and examine new data that had not been available to date.

Accordingly, the Working Group collected and analyzed new data and input from a number of sources via surveys to various stakeholders, interactions with service providers, analysis conducted by third parties, and other methods. A non-exhaustive list of these sources follows.

### URS Data

- Information provided by URS Providers (March 2018), as well as data gathered from the URS Providers' websites, tools, and platforms;
- Survey responses from the URS Providers and a number of experienced URS practitioners (June/August 2018);
- INTA's New gTLD Cost Impact Survey results, prepared for ICANN's CCT Review (April/May 2017);
- Data and analysis of all URS cases provided by Professor Rebecca Tushnet, a Working Group member (May 2018).

### TMCH Data

- Registry responses to TMCH Sub-Team developed survey (December 2016);
- The Analysis Group's Independent Review of the TMCH Services Revised Report (February 2017) and its responses to Working Group questions about that report (June/July 2016);
- INTA's New gTLD Cost Impact Survey results (April/May 2017);
- Data from Deloitte (the TMCH Validation Provider) (February 2017) and its responses to Working Group questions (January/April 2017).

### Sunrise & Trademark Claims Services Data

- Responses from registries, registrars, trademark owners, and actual/potential registrants to the Sunrise and Trademark Claims surveys conducted by the Analysis Group (October 2018);<sup>1</sup>
- Registry responses to a TMCH Sub-Team developed survey (December 2016).

#### **TM-PDDRP Data**

- Responses from TM-PDDRP Providers (WIPO, FORUM, and ADNDRC) to Working Group questions (June/September 2016);
- WIPO's proposal to amend the TM-PDDRP (March 2009) and community responses to the proposal (March-December 2009).

#### **Additional Marketplace RPMs Data**

- Registry responses to a TMCH Sub-Team developed survey (December 2016);
- Information shared with the additional marketplace RPMs Sub-Team by Donuts, Inc., a Registry Operator offering additional marketplace RPMs, during the ICANN61 Puerto Rico meeting (March 2017).

Links to some of the data/input sources that the Working Group analyzed are included in the "Annex E - Working Group Documents" section of its Phase 1 Final Report. For a complete record of data/input source documents and materials, please visit the Working Group [wiki workspace](#).

Although the Working Group engaged in extensive data collection and analysis efforts during its deliberations, it experienced difficulties in obtaining quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the Phase 1 RPMs. As a result, the Working Group developed an Overarching Data Collection Recommendation aiming at addressing this data-related gap.

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<sup>1</sup> ICANN org commissioned these surveys pursuant to a data request approved by the GNSO Council in September 2017

## 6. Final Report Submission

The Working Group's Phase 1 Final Report was submitted to the GNSO Council on 24 November 2020 and can be found in full [here](#). The full text of all approved recommendations are included as an annex to this Recommendations Report.

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## 7. Council Deliberations

*A copy of the minutes of the Council deliberation on the policy issue, including all opinions expressed during such deliberation, accompanied by a description of who expressed such opinions.*

Between the submission of the Phase 1 Final Report in November 2020 and the GNSO Council's vote in January 2021, the GNSO Council discussed the Working Group's recommendations on several occasions, including at a webinar conducted on 11 January 2021 and during the GNSO Council's meeting on 17 December 2020.<sup>2</sup>

On 11 January 2021, John McElwaine, the GNSO Council Liaison to the RPM PDP, [submitted](#) a motion to approve the Phase 1 Final Report to the GNSO Council mailing list. The GNSO Council passed the [resolution](#) via a unanimous vote during its meeting on 21 January 2021. For additional details, see the [transcript](#) and the [minutes](#) from the GNSO Council's January 2021 meeting.

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<sup>2</sup> The slide deck, transcript, and recording of the webinar can be found at: <https://gns0.icann.org/en/group-activities/calendar#jan>

## 8. Consultations Undertaken

In accordance with the requirements of the GNSO PDP Manual, the Working Group solicited early input from ICANN’s Supporting Organizations and Advisory Committees as well as the GNSO’s Stakeholder Groups and Constituencies. Please see Annex G of the Final Report for more details.

As mentioned in Section 5 of this report, the Working Group engaged in extensive data collection and analysis efforts during its deliberations. Please see “Section 6.3 Data Gathering and Review” of the Final Report for more details.

During its deliberations, the Working Group also consulted ICANN org’s Global Domains and Strategy (GDS) department to answer specific questions or solicit input on proposed recommendations. GDS staff also observed some of the Working Group meetings, especially during the Working Group’s finalization process of its Phase 1 recommendations.

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## 9. Summary and Analysis of Public Comment Forum

*Summary and analysis of Public Comment Forum to provide input on the Initial Report.*

As mandated by the GNSO's PDP Manual, the Working Group published its [Phase 1 Initial Report for public comment](#) on 18 March 2020. The Working Group used a Google Form to collect public comments. [Fifty-five \(55\) contributions](#) were received (38 from organizations, five from ICANN community groups, and 12 from individuals).

To facilitate its review and analysis of the public comments received, the Working Group used a set of [public comment review tools and analysis summary documents](#). From May to September 2020, the Working Group completed its review and assessment of the public comments received through online review, sub-team processes, and plenary sessions. As documented in its Phase 1 Final Report, the Working Group agreed to amend some of its preliminary recommendations and include additional recommendations as a result of its review of the input received through the Public Comment Forum.

## 10. Impact/Implementation Considerations from ICANN Staff

The internal ICANN org implementation team is expected to comprise the staff members who have been working on the RPMs and associated structures and procedures applicable to gTLDs launched under the 2012 New gTLD Program. Given the large number of recommendations impacting various stakeholders and the need for coordination with other parallel efforts, ICANN org considers the scope of effort required for this implementation to be substantial.

## Annex A: Phase 1 Final Recommendations from the PDP Working Group on the Review of All Rights Protection Mechanisms in All gTLDs (extracted from the Final Report)

### URS Recommendations for New Policies and Procedures

#### **URS Final Recommendation #1**

The Working Group recommends that URS Rule 3(b), and, where necessary, a URS Provider's Supplemental Rules be amended to clarify that a Complainant must only be required to insert the publicly-available WHOIS/Registration Data Directory Service (RDDS) data for the domain name(s) at issue in its initial Complaint.

Furthermore, the Working Group recommends that URS Procedure paragraph 3.3 be amended to allow the Complainant to update the Complaint within 2-3 calendar days after the URS Provider provides updated registration data related to the disputed domain name(s).

#### **URS Final Recommendation #2**

The Working Group recommends that URS Rule 15(a) be amended to clarify that, where a Complaint has been updated with registration data provided to the Complainant by the URS Provider, URS Panelists have the discretion to decide whether to publish or redact such data in the Determination. The Working Group further recommends that each URS party has the right to request that Panelists consider redacting registration data elements from publication as part of the Determination.

#### **URS Final Recommendation #3**

The Working Group recommends that the URS Rules be amended to incorporate in full Rule #11 of the UDRP Rules regarding "Language of Proceedings", see:

<https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.”

#### **Implementation Guidance:**

As implementation guidance, the Working Group recommends that the IRT consider the following:

- Preliminary submissions by either side to the Panel regarding the language of the proceeding should be limited to 250 words, and not be counted against the existing URS word limits.
- The Notice of Complaint should, where applicable, contain a section explaining that the Respondent may make a submission regarding the language of the proceedings.
- If a translation is ordered by the URS Examiner, as long as the original submission meets the word limits in the original language, the translation of the original submission may nominally exceed the prescribed word limit; for the avoidance of doubt, the translation may not introduce new facts or arguments which may be contained in the Language of Proceeding submission.
- The IRT should consider developing potential guidance to assist URS Examiners in deciding whether to deviate from the default language in the context of a particular proceeding. Such potential guidance may take into account the language of the relevant registration agreement (irrespective of whether the domain is registered through a privacy or proxy service or reseller). Such potential guidance could also consider the relevance of other factors, including but not limited to:
  - the language requested by one of the URS parties;
  - the predominant language of the country or territory of the registrant;
  - principles articulated in the relevant section (presently 4.5) of the WIPO Overview;<sup>3</sup>
  - the language used by the registrar and/or predominant language of the country/territory of the registrar, if different from the language of the registration agreement; and
  - the language/script used in the domain name (including the TLD), in particular if it is an Internationalized Domain Name.

#### **URS Final Recommendation #4**

The Working Group recommends that the URS Rule 4(b) and URS Procedure paragraph 4.2 be amended to require the Provider to transmit the Notice of Complaint to the Respondent in English and translate it into the language of the Registration Agreement.

The Working Group further recommends that it be mandatory for URS Providers to comply with URS Procedure paragraph 4.3 and transmit the Notice of Complaint to the Respondent via email, fax, and postal mail.

#### **URS Final Recommendation #5**

The Working Group recommends that the URS Procedure paragraph 6.2 be amended to: (i) clearly define what “Default Period” means; and (ii) state that the registrant shall not change

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<sup>3</sup> See WIPO Overview Section 4.5 here: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item45>

the public and non-public registration data elements related to the disputed domain name(s) during the Default Period.

The Working Group further recommends deleting the text “the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use” from URS Procedure paragraph 6.2, and incorporating it in other appropriate section(s) in the URS Procedure as factors which an Examiner may take into account in determining whether there was registration and use in bad faith.

**Implementation Guidance:**

For consideration of the IRT, the Working Group suggests that the deleted text may be incorporated in URS Procedure paragraph 5.9 and/or 8.1.<sup>4</sup>

**URS Final Recommendation #6**

The Working Group recommends that the URS Rule 6(a) be amended to clarify that each URS Provider shall maintain and publish a publicly available list of Examiners and their qualifications through regular updating and publication of their Examiners’ curriculum vitae (CV).

The Working Group further recommends that the URS Procedure paragraph 7 be amended to add a requirement that each URS Provider shall publish their roster of Examiners who are retained to preside over URS cases, including identifying how often each one has been appointed together with a link to their respective decisions.

**Implementation Guidance:**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- As URS Providers cannot compel Examiners to provide updates or verify if there are changes to each Examiner’s qualifications and professional affiliations, URS Providers shall be required to request that Examiners update their CV’s as prescribed, keep their CV’s current and submit any updates to the Provider;
- It will be sufficient to satisfy the objective of providing public visibility of Examiner rotations if a Provider’s website provides a mechanism or function where one can search for those URS decisions that a specific Examiner presided over.

**URS Final Recommendation #7**

The Working Group recommends that the URS Rule 6 be amended to add a requirement that each URS Provider shall publish an effective Examiner Conflict of Interest (COI) policy that the Provider reasonably enforces against any Examiners who violate such policy.

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<sup>4</sup> See the full text of the URS Procedure paragraphs 5.9 and 8.1 here:  
<http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

**URS Final Recommendation #8**

The Working Group recommends that the ICANN org establishes a compliance mechanism or mechanisms to ensure that URS Providers, Registries, and Registrars operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process.

The Working Group recommends that such compliance mechanism(s) should include an avenue for any party in the URS process to file complaints and seek resolution of noncompliance issues.

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that the IRT consider:

- Investigating different options for potential compliance mechanism(s), such as ICANN Compliance, other relevant department(s) in ICANN org, a URS commissioner at ICANN org, a URS standing committee, etc.
- Developing metrics for measuring performance of URS Providers, Registries, and Registrars in the URS process.

**URS Final Recommendation #9**

The Working Group recommends that a uniform set of educational materials be developed to provide guidance for URS parties, practitioners, and Examiners on what is needed to meet the “clear and convincing” burden of proof in a URS proceeding.

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that the educational materials should be developed in the form of an administrative checklist, basic template, and/or FAQ. Specifically, the Working Group recommends that the educational materials should be developed with help from URS Providers, Practitioners, Panelists, as well as researchers/academics who study URS decisions closely. The Working Group suggests that the IRT consider the following:

- 1) reaching out to the broader multistakeholder community, including Providers/experts, to assist ICANN org and the IRT to develop those educational materials;
- 2) ICANN org should bear the cost; and
- 3) translations of the resulting materials should be provided.

**URS Final Recommendation #10**

The Working Group recommends that clear, concise, easy-to-understand informational materials should be developed, translated into multiple languages, and published on the URS Providers’ websites to assist Complainants and Respondents in URS proceedings. Such informational materials should include, but not be limited to the following: 1) a uniform set of basic FAQs, 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain the URS Providers’ services and practices.

## URS Recommendations to Modify Existing Operational Practice

**URS Final Recommendation #11**

The Working Group recommends that URS Providers send notices to the Respondent by the required methods after the Registry or Registrar has forwarded the relevant WHOIS/RDDS data (including contact details of the Registered Name Holder) to the URS Providers.

**URS Final Recommendation #12**

The Working Group recommends that the ICANN org, Registries, Registrars, and URS Providers take appropriate steps to ensure that each other's contact details are up to date in order to effectively fulfill the notice requirements set forth in the URS Procedure paragraph 4.

**URS Final Recommendation #13**

The Working Group recommends that all URS Providers require their Examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that URS Providers provide their Examiners a set of basic guidance for documenting their rationale for a Determination. The purpose is to ensure consistency and precision in terminology and format as well as ensure that all steps in a proceeding are recorded. Such guidance may take the form of an administrative checklist or template of minimum elements that need to be included for a Determination; specifically and at a minimum, that the relevant facts are spelled out and each of the three URS elements listed in the original language of the Determination are addressed in the Determination.<sup>5</sup>

**URS Final Recommendation #14**

The Working Group recommends that the IRT consider reviewing the implementation issues identified by the Working Group with respect to Registry Requirement 10 in the "URS High Level Technical Requirements for Registries and Registrars" and amend Registry Requirement 10, if deemed necessary.<sup>6</sup>

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<sup>5</sup> The URS requires a trademark owner, or the "Complainant," to show all three of the following elements: (i) The disputed domain name is identical or confusingly similar to a word mark that meets certain criteria; (ii) the registrant of the domain name, or the "respondent," has no legitimate right or interest to the domain name; and (iii) the domain name was registered and is being used in bad faith.

<sup>6</sup> URS Technical Requirements for Registries and Registrars can be downloaded here:  
<https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

For clarity, the Working Group notes that this recommendation is not intended to create any transfer remedy for the URS. In addition, the Working Group agrees that as set out in the URS Rules and Procedure, a domain name suspension can be extended for one additional year, and the Whois for the domain name shall continue to display all of the information of the original Registrant and reflect that the domain name will not be able to be transferred, deleted, or modified for the life of the registration.<sup>7</sup>

#### **URS Final Recommendation #15**

The Working Group recommends that the "URS High Level Technical Requirements for Registries and Registrars" document be renamed as the "URS High Level Requirements for Registries and Registrars". The Working Group also recommends that on ICANN org's web page <https://newgtlds.icann.org/en/applicants/urs>, the "URS Technical Requirements 1.0" document be renamed as the "URS Registrars and Registries Requirements 1.0".

## TMCH Recommendations for New Policies and Procedures

#### **TMCH Final Recommendation #1**

##### **Agreed Policy Principles:**

The Working Group recommends that the scope and applicability of the TMCH be clarified and limited in accordance with the following agreed policy principles:

1. Only word marks that meet one of the following requirements are eligible for the mandatory Sunrise and Trademark Claims RPMs:
  - a. Nationally or regionally registered word marks from all jurisdictions; or
  - b. Word marks validated by a court of law or other judicial proceeding; or
  - c. Word marks that are protected by a statute or treaty that is in effect at the time the mark is submitted to the TMCH and that are listed with a national or regional trademark office. This provision is important for the protection of certain marks of international governmental and non-governmental organizations (see Explanatory Note below).

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<sup>7</sup> **URS Rule 14(b):** If the Complainant wishes to extend the remedy for an additional year per URS Procedure paragraph 10.3, Complainant shall contact the Registry Operator directly regarding this option.

**URS Procedure paragraph 10.2:** Immediately upon receipt of the Determination, the Registry Operator shall suspend the domain name, which shall remain suspended for the balance of the registration period and would not resolve to the original web site. The Registry Operator shall cause the nameservers to redirect to an informational web page provided by the URS Provider about the URS. The URS Provider shall not be allowed to offer any other services on such page, nor shall it directly or indirectly use the web page for advertising purposes (either for itself or any other third party). The Whois for the domain name shall continue to display all of the information of the original Registrant except for the redirection of the nameservers. In addition, the Registry Operator shall cause the Whois to reflect that the domain name will not be able to be transferred, deleted or modified for the life of the registration.

**URS Procedure paragraph 10.3:** There shall be an option for a successful Complainant to extend the registration period for one additional year at commercial rates.

2. “Word marks” include service marks, collective marks, certification marks and word marks protected by statute or treaty, as further limited by Policy Principle #3 below.
3. Geographical indications, protected designations of origin, and other signs protected by quality schemes for distinguishing or indicating the geographic source or quality of goods or services are not eligible for the mandatory Sunrise and Trademark Claims RPMs unless they are also trademarks as defined in 1(a) or 1(b) above.<sup>8</sup>
4. The TMCH Validation Provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders. To the extent that the TMCH Validation Provider validates and accepts other forms of intellectual property (such as geographical indications) in order to provide such additional voluntary services, these other forms of intellectual property must be held in a separate ancillary database.

**Implementation Guidance:**

The Working Group recommends that the Implementation Review Team (IRT) consider adopting the following language in amending the Module 5 Trademark Clearinghouse of the Applicant Guidebook to reflect the agreed policy principles noted above:

3.2.1 Nothing in this section shall exclude the TMCH Validation Provider and registry operators from offering additional voluntary services to mark holders.

3.2.2 In this section “word mark” includes service marks, collective marks, certification marks, and word marks protected by statute or treaty.

3.2.3 The standards for inclusion in the Clearinghouse in order to be eligible for the mandatory Trademark Claims and Sunrise RPMs are:

- (1) Nationally or regionally registered word marks from all jurisdictions;
- (2) Word marks that have been validated through a court of law or other judicial proceeding;
- (3) Word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion and listed at a national or regional trademark office.
- (4) Subsection (3) does not apply to geographical indications, protected designations of origin, or other quality schemes unless they also satisfy subsections (1) or (2).

3.2.4 The standards for being validated and accepted for the sole purpose of inclusion in ancillary databases to permit the provision of additional voluntary services, but not for the purpose of accessing mandatory Trademark Claims or Sunrise RPMs are:

- (1) Other marks that constitute intellectual property;
- (2) Geographical indications, protected designations of origin, or other quality schemes for distinguishing or indicating the geographic source or quality of goods or services.

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<sup>8</sup> The Working Group is using the phrase “quality scheme” in the sense used by the European Union when describing its quality policy: see, e.g.: [https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained\\_en](https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en)

3.2.5 Applications for trademark registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings are not eligible for inclusion in the Clearinghouse.

Explanatory Note in relation to word marks protected by statute or treaty:

Treaty organizations and non-governmental organizations protected by statute are not always able to register their word marks at a national trademark office. In some jurisdictions their marks are reflected as a “non-registration” (e.g. the 89 series in the United States Patent & Trademark Office) which ensures no one can subsequently register those marks as a trademark or are otherwise listed with the relevant trademark office. Where such word marks are listed with a national or regional trademark office, they must be treated within the Clearinghouse in the same way as a registered word mark or a court validated word mark and must be eligible for Claims and Sunrise.

An illustrative example of a network of societies whose word marks are protected by international treaty and national statutes is the Red Cross, whose signs and emblems are protected by the Geneva Conventions, and which has signs listed, inter alia, in the 89 series at the United States Patent & Trademark Office.

## TMCH Recommendation to Maintain Status Quo

### **TMCH Final Recommendation #2**

The Working Group considered the following aspects of the TMCH:<sup>9</sup>

1. Whether the “TM +50” rule should be changed or maintained;
2. Whether the current “exact match” rules should be changed or maintained; and
3. Whether, where a trademark contains dictionary term(s), the Sunrise and Trademark Claims RPMs should be changed such as to be limited in their scope to be applicable only in those gTLDs that pertain to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group’s recommendation for these three questions is that the status quo (i.e. the current rules as applied to the gTLDs delegated under the 2012 New gTLD Program round) should be maintained.

## TMCH Recommendations to Modify Existing Operational Practice

### **TMCH Final Recommendation #3**

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<sup>9</sup> For additional details about the TMCH, please see Trademark Clearinghouse in Module 5 of the gTLD Applicant Guidebook: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

The Working Group recommends that the TMCH Validation Provider be primarily responsible for educating rights-holders, domain name registrants, and potential registrants about the services it provides.

The Working Group also recommends that the IRT work with the TMCH Validation Provider and consider enhancing existing educational materials already made available by the TMCH Validation Provider, with additional attention to providing information that can benefit domain name and potential registrants.

#### **TMCH Final Recommendation #4**

The Working Group recommends that the Trademark Clearinghouse database provider be contractually bound to maintain, at minimum, industry-standard levels of redundancy and uptime.

#### **Implementation Guidance**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- Consider the advisability of requiring that more than one provider be appointed; and
- Review the work of the Implementation Advisory Group that was formed for the 2012 New gTLD Program to assist ICANN org with developing the specifications for and design of the Trademark Clearinghouse.<sup>10</sup>

## Sunrise Recommendation for New Policies and Procedures

#### **Sunrise Final Recommendation #1**

The Working Group recommends that the Registry Agreement for future new gTLDs include a provision stating that a Registry Operator shall not operate its TLD in such a way as to have the effect of intentionally circumventing the mandatory RPMs imposed by ICANN or restricting brand owners' reasonable use of the Sunrise RPM.

#### **Implementation Guidance:**

The Working Group agrees that this recommendation and its implementation are not intended to preclude or restrict a Registry Operator's legitimate business practices that are otherwise compliant with ICANN policies and procedures.

## Sunrise Recommendations to Maintain Status Quo

#### **Sunrise Final Recommendation #2**

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<sup>10</sup> See details about the Implementation Advisory Group here: <https://newgtlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf>

In the absence of wide support for a change to the status quo, the Working Group recommends that the mandatory Sunrise Period should be maintained for all new gTLDs, with the sole exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalent in the next new gTLD expansion round).<sup>11</sup>

#### **Sunrise Final Recommendation #3**

The Working Group recommends that the current requirement for the Sunrise Period be maintained, including for the 30-day minimum period for a Start Date Sunrise and the 60-day minimum period for an End Date Sunrise.

#### **Sunrise Final Recommendation #4**

In the absence of wide support for a change to the status quo, the Working Group recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not be expanded.

#### **Sunrise Final Recommendation #5**

In the absence of wide support for a change to the status quo, the Working Group does not recommend limiting the scope of Sunrise Registrations to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse.

#### **Sunrise Final Recommendation #6**

In the absence of wide support for a change to the status quo, the Working Group does not recommend the creation of a challenge mechanism relating to Registry Operators' determinations of Premium and/or Reserved Names.<sup>12</sup>

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<sup>11</sup> See **Specification 13 .Brand TLD Provisions** here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-specification-13-31jul17-en.pdf>;

The exemption language in **Section 6 of Specification 9 Registry Operator Code of Conduct** is as follows: "Registry Operator may request an exemption to this Code of Conduct, and such exemption may be granted by ICANN in ICANN's reasonable discretion, if Registry Operator demonstrates to ICANN's reasonable satisfaction that (i) all domain name registrations in the TLD are registered to, and maintained by, Registry Operator for the exclusive use of Registry Operator or its Affiliates, (ii) Registry Operator does not sell, distribute or transfer control or use of any registrations in the TLD to any third party that is not an Affiliate of Registry Operator, and (iii) application of this Code of Conduct to the TLD is not necessary to protect the public interest." See full text of the Specification 9 here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.html#specification9>.

More information about the Specification 9-exempted TLDs can be found here.

<sup>12</sup> **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Reserved Name:** All registry operators are required by their Registry

**Sunrise Final Recommendation #7**

In the absence of wide support for a change to the status quo, the Working Group does not recommend mandatory publication of the Reserved Names lists by Registry Operators.

## Sunrise Recommendation to Modify Existing Operational Practice

**Sunrise Final Recommendation #8****Agreed Policy Principles:**

The Working Group agrees that the TMCH dispute resolution procedure should be the primary mechanism for challenging the validity of the Trademark Record on which a registrant based its Sunrise registration.

While the Working Group agrees that the Sunrise Dispute Resolution Policy (SDRP) allows challenges to Sunrise registrations related to Registry Operator's allocation and registration policies, it is not intended to allow challenges to Sunrise registrations on the grounds that the Trademark Record on which the registrant based its Sunrise registration is invalid.

The Working Group therefore recommends that, once informed by the TMCH Validation Provider that a Sunrise registration was based on an invalid Trademark Record (pursuant to a TMCH dispute resolution procedure), the Registry Operator must immediately suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure.

**Implementation Guidance:**

The Working Group suggests that the IRT consider incorporating the following requirements to amend the Applicant Guidebook (AGB) to reflect the above-noted policy principles.

1. The new version of the AGB should include the TMCH dispute resolution procedure for challenging the validity of trademark records entered into the TMCH. This procedure is currently published at: <https://www.trademark-clearinghouse.com/dispute#3.3>. ICANN org should ensure that its contract for the provision of TMCH services makes the publication and operation of the TMCH dispute resolution procedure a requirement for the TMCH Validation Service Provider.
2. Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5 of the AGB be amended to remove grounds (i) and (iii) for the SDRP.<sup>13</sup>

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Agreement (RA) to exclude certain domain names from registration in a TLD. These reserved names include strings that are for Country Code Top Level Domains (ccTLDs), ICANN-related names (such as "ICANN"), IANA-related names (such as "example"), country and territory names, international and intergovernmental organizations, and names that the registry operator can use in connection with the operation of the TLD.

<sup>13</sup> In this recommendation, some of the terms are capitalized in accordance with the terms used in the AGB. These terms include but are not limited to: "Trademark Clearinghouse Model of Module 5", "Sunrise Registration", "TMCH Validation Provider", "Trademark Holder", and "Trademark Agent".

3. The Trademark Clearinghouse Model of Module 5 of the AGB be amended to include a new Section 6.2.6, with suggested language as follows – “The Registry Operator will, upon receipt from the TMCH of a finding that a Sunrise registration was based upon an invalid TMCH record (pursuant to a TMCH dispute resolution procedure), immediately suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure. As a point of reference, Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH dispute resolution procedure and provide a link to the relevant resource on the TMCH Validation Provider’s site.”

Note: Registry Operators should continue to have the option to offer a broader SDRP to include optional/additional Sunrise criteria as desired.

### Trademark Claims Recommendations for New Policies or Procedures

#### Trademark Claims Final Recommendation #1

The Working Group recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration, with the exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalents in subsequent new gTLD expansion rounds).<sup>14</sup>

#### Trademark Claims Final Recommendation #2

The Working Group recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Working Group recommends:

- Changing the relevant language in the current Trademark Clearinghouse Rights Protection Mechanism Requirements on this topic (Section 3.3.1.2) to “...registrars **MUST** provide the Claims Notice in English and in the language of the registration agreement.”<sup>15</sup>
- The Claims Notice **MUST** include a link to a webpage on the ICANN org website which contains translations of the Claims Notice in all six UN languages.

### Trademark Claims Recommendations to Maintain Status Quo

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<sup>14</sup> For more information about Specification 13 and Section 6 of Specification 9, please see the footnote of Sunrise Final Recommendation #2.

<sup>15</sup> See the Trademark Clearinghouse Rights Protection Mechanism Requirements here:  
<http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

**Trademark Claims Final Recommendation #3**

The Working Group recommends, in general, that the current requirement for a mandatory Claims Period, including the minimum initial 90-day period when a TLD opens for general registration, be maintained.

The Working Group further recommends that if a Registry Operator offers a Limited Registration Period, the Registry Operator must maintain the current requirement pursuant to RPM Requirements Section 3.2.5 and provide the Claims Services during the entire Limited Registration Period in addition to the minimum initial 90-day Claims Period when the TLD opens for general registration.<sup>16</sup>

**Trademark Claims Final Recommendation #4**

In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.

## Trademark Claims Recommendations to Modify Existing Operational Practice

**Trademark Claims Final Recommendation #5**

The Working Group recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.

**Implementation Guidance:**

The Working Group agrees that the IRT needs to recognize that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.

For clarity, the Working Group notes that this recommendation is not intended to preclude or restrict Registrars' legitimate business practice of pre-registration, provided this is compliant with the Trademark Claims service requirements.

The Working Group requests that the IRT uses appropriate flexibility and consider ways in which ICANN org can work with Registrars to address all relevant implementation issues (e.g., possibly alter the 48-hour expiration period of the Claims Notice as the IRT deems appropriate), but which will continue to allow legitimate pre-registration programs compliant with RPM requirements to continue.

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<sup>16</sup> RPM Requirements Section 3.2.5 states: "If Registry Operator offers a Limited Registration Period, Registry Operator MUST provide the Claims Services during the entire Limited Registration Period in addition to the standard Claims Period. For the avoidance of doubt, the first ninety (90) calendar days of General Registration must employ the Claims Services, regardless of any other registration period prior to the start of General Registration." See p.10 here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-14may14-en.pdf>

**Trademark Claims Final Recommendation #6**

The Working Group recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined below. This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing the risk of unintended effects or consequences of deterring good-faith domain name applications.

The Working Group agrees that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take, following receipt of a notice).

**Implementation Guidance:**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP in redrafting the Claims Notice, the Working Group has developed the following Implementation Guidance:

- The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law;
- The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications;
- The Working Group advises that the IRT use appropriate flexibility and consider whether it believes it will be helpful to solicit input from resources internal and/or external to the ICANN community as the IRT deems necessary and appropriate. Suggested external resources could include academic and industry sources such as the American University Intellectual Property Clinic, INTA Internet Committee, the Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN. The IRT may also, in its discretion, consider input from communications experts, who can help review the Claims Notice for readability purposes and ensure it is understandable to the general public.

## TM-PDDRP Recommendation for New Policies or Procedures

**TM-PDDRP Final Recommendation**

The Working Group recommends that Rule 3(g) of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Rules be modified, to provide expressly that multiple

disputes filed by unrelated entities against a Registry Operator may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request.<sup>17</sup>

This recommendation is intended to clarify the fact that the TM-PDDRP permits the joint filing of a Complaint and the consolidation of Complaints by several trademark owners, even if these are unrelated entities, against a Registry Operator in the case where: (a) that Registry Operator has engaged in conduct that has affected the Complainants' rights in a similar fashion; and (b) it will be equitable and procedurally efficient to permit the consolidation.

To the extent that a TM-PDDRP Provider's current Supplemental Rules may not permit the filing of a joint Complaint or the consolidation of several Complaints, the Working Group further recommends that those Providers amend their Supplemental Rules accordingly.<sup>18</sup>

For the avoidance of doubt, the Working Group notes that:

1. The filing of a joint Complaint or consolidation is to be permitted only where: (i) the Complaints relate to the same conduct by the Registry Operator, at the top or the second level of the same gTLD for all Complaints; and (ii) all the trademark owners have satisfied the Threshold Review criteria specified in Article 9 of the TM-PDDRP;<sup>19</sup> and
2. This recommendation is intended to apply to two distinct situations: one where several trademark owners join together to file a single Complaint, and the other where several trademark owners each file a separate Complaint but request that these be consolidated into a single Complaint after filing.

## Overarching Data Collection Final Recommendation

### Overarching Data Collection Final Recommendation

In relation to the TMCH, the Working Group recommends that, for future new gTLD rounds, ICANN Org collect the following data on at least an annual basis (to the extent it does not do so already) and make the data available to future RPM review teams:

- Number of marks submitted for validation in each category of marks accepted by the TMCH;

<sup>17</sup> Including those under common control, see definition at **TM-PDDRP Article 6**: "For purposes of these standards, "registry operator" shall include entities directly or indirectly controlling, controlled by or under common control with a registry operator, whether by ownership or control of voting securities, by contract or otherwise where 'control' means the possession, directly or indirectly, of the power to direct or cause the direction of the management and policies of an entity, whether by ownership or control of voting securities, by contract or otherwise." More details of the TM-PDDRP can be found here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

<sup>18</sup> The Supplemental Rules of the three TM-PDDRP Providers can be found here - ADNDRC: [https://www.adndrc.org/mten/img/pdf/Supplemental\\_Rules\\_TMPDDRP\\_10-03-2014.pdf](https://www.adndrc.org/mten/img/pdf/Supplemental_Rules_TMPDDRP_10-03-2014.pdf); FORUM: <https://www.adrforum.com/assets/resources/gTLD/Supplemental%20Rules-PDDRP.pdf>; and World Intellectual Property Organization (WIPO): <https://www.wipo.int/export/sites/www/amc/en/docs/supplrulestmpddrp.pdf>

<sup>19</sup> See the Threshold Review criteria in Article 9 of TM-PDDRP on pp.5-6 here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

- Number of successfully validated marks in each category of marks accepted by the TMCH;
- Number of labels generated for all successfully validated marks;
- Number of abused labels;<sup>20</sup>
- Number of marks deactivated in and removed from the TMCH;
- Breakdown of the scripts/languages represented in a validated and active trademark in the TMCH; and
- Number of cases decided under the TMCH dispute resolution procedure.

In relation to the Trademark Claims service, the Working Group recommends that, for future new gTLD rounds, ICANN-accredited registrars must provide ICANN Org with periodic reports of the number of Claims Notices that were sent out to prospective registrants not less than every 12 months.

In relation to the URS, the Working Group recommends that ICANN Org explore developing a mechanism, in consultation with the URS Providers, to enable publication and search of all URS Determinations in a uniform format.

The Working Group further recommends that, in implementing Board-adopted recommendations from the 2018 Final Report of the Competition, Consumer Choice & Consumer Trust Review Team, ICANN org also collect data concerning trademark owners' and registrants' experience with the RPMs that can be provided to future GNSO RPM policy review teams (including result of studies that ICANN org may conduct pursuant to Recommendations #26, if approved by the ICANN Board, and #28).<sup>21</sup>

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<sup>20</sup> The term "abused label" refers to those labels associated with a verified trademark record in the TMCH that a trademark owner may register, where the domain was the subject of a determination in a prior UDRP case or court decision in which the rights holder prevailed. A trademark owner may register up to 50 such labels. The TMCH Validator examines UDRP Providers' database information and court case documentation to ensure each label submitted meets this criterion: see <https://newgtlds.icann.org/en/announcements-and-media/announcement-11oct13-en>

<sup>21</sup> **CCT Review Team's Final Report:** <https://www.icann.org/en/system/files/files/cct-final-08sep18-en.pdf>

**CCT Recommendation #26:** "A study to ascertain the impact of the New gTLD Program on the costs required to protect trademarks in the expanded DNS space should be repeated at regular intervals to see the evolution over time of those costs. The CCT Review Team recommends that the next study be completed within 18 months after issuance of the CCT Final Report, and that subsequent studies be repeated every 18 to 24 months". As of September 2020, this recommendation remains in pending status, i.e. it has not yet been approved by the ICANN Board.

**CCT Recommendation #28:** "A cost-benefit analysis and review of the Trademark Clearinghouse (TMCH) and its scope should be carried out to provide quantifiable information on the costs and benefits associated with the present state of the TMCH services and thus to allow for an effective policy review".